

### **REMARKS/ARGUMENTS**

This amendment is submitted in response to the Office Action dated December 22, 2004. After entry of this amendment, claims 1-11, 13-23, and 26-35 will be pending in the application. Claims 1, 13, and 26 have been amended in order to clarify the language. Claims 12, 24, 25, and 36 have been canceled. Reconsideration and allowance is respectfully requested in view of the amendments made and the remarks made below.

#### **1. The Examiner's Interview**

The Applicant would like to thank the Examiner for granting the Applicant a telephonic interview on June 10, 2005 with Mr. Kupstas. During the course of the interview U.S. Patent No. 6,682,121 and U.S. Patent No. 1,621,972 were discussed in light of independent claim 1. It was argued that U.S. Patent No. 6,682,121 did not disclose the limitation of having a temperature indicator positioned to be thermally insulated from the window. The Examiner maintained that U.S. Patent No. 6,682,121 did disclose this limitation. It was also noted by Mr. Kupstas that none of the cited references disclosed having a temperature indicator located on the handle of a window shade. The Examiner maintained that this would be obvious. No agreement was reached regarding the Application.

#### **2. The Rejection under 35 U.S.C. §112, First Paragraph.**

Claims 12, 24, 25, and 36 were rejected in the Office Action under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The Applicant maintains that these claim limitations are fully enabled since one of ordinary skill in the art would have the necessary knowledge required to wire a temperature indicator to a visual or auditory alarm. However, in the interest of furthering prosecution the Applicant has canceled these claims.

The Applicant respectfully submits that the rejection under § 112, first paragraph, should be removed.

### **3. The Rejection under 35 U.S.C. § 103(a)**

Claims 1-11, 13-23, and 26-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 1,621,972 to Darby (hereinafter “Darby”) in view of U.S. Patent No. 6,682,121 to Conforti (hereinafter “Conforti”). The Applicant respectfully submits that neither Darby, nor Conforti, either alone or in combination, teach each and every element of the claims.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 265 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Darby teaches having an antiglare shield for motor vehicles. The device is placed on the windshield of a vehicle. The device uses a roller that is used in conjunction with a sheet of pyralin material. The device is mounted detachably upon the windshield and is attached via elements 36 and 33. Element 37 is a small rectangular tab-like piece that extends at a right angle to strip 10 and acts as a handle. As noted in the Office Action, there is no teaching or suggestion of having a temperature indicator located on the device.

Conforti discloses a shade for use in a car that has no mechanical features and simply consists of material 12 and fastening devices 14. Additionally, adhesive strips or clips may be used. Temperature indicators can be disposed at various locations on the material. Conforti does not disclose having a temperature indicator located so that it is thermally insulated. Conforti makes no mention of even approximating this goal.

Independent claims 1, 13, and 26 all require that a temperature sensor be placed on a widow shade so as to be thermally insulated. This achieves the goal of assisting in providing an accurate reading of the temperature of the interior of the car. This goal can be accomplished in a variety of ways, none of which are taught or suggested by Conforti. One method used in the Application is to place the temperature sensor on the handle of the window shade. In another embodiment the temperature sensor is placed on the housing. In another embodiment the temperature sensor 38 is placed on shade element 22. See Figure 3. This represents the scenario

that most closely represents the Examiner's proposed combination. In this embodiment the thermochromic material 36 is recessed within plastic material. Furthermore, the shade element 22 is spaced from the vehicle window 23 by a distance of at least one millimeter. See page 6, lines 13-16 also see page 4, lines 23-27. In the Specification, the Applicant clearly sets forth the manner in which thermal insulation is achieved. Conforti makes no mention of providing any minimum spacing in order to achieve thermal insulation or even suggests that providing thermal insulation is important. Conforti makes no distinction between placing a temperature indicator on a shade that is flush with a vehicle window and placing it on a shade so that it is thermally insulated. As such, one of ordinary skill in the art would not have the requisite teaching or knowledge in order to position the temperature indicator taught in Conforti on the shade taught by Darby in a position that would make it thermally insulated, since neither Darby nor Conforti teach or suggest thermally insulating a temperature indicator. It is not a foregone conclusion that simply placing a temperature indicator on a shade would result in a thermally insulating it. Combining the teaching of Conforti with the teaching of Darby would not result in the Applicant's invention.

The Applicant respectfully submits that claims 1, 13, and 26 are all in condition for allowance. Claims 2-11, 14-23, and 27-35 are also in condition for allowance by virtue of their being dependent upon allowable base claims.

Claims 4, 16, and 31 are also allowable because neither Conforti nor Darby teaches having a temperature sensor placed upon a handle. Darby teaches having a handle for use with a shade, however the handle disclosed in Darby is in the shape of a pull-tab for the window shade and not the more sizable shape of the handle structure used by the Applicant. The handle in Darby is not amenable to having a temperature sensor placed upon it. Conforti teaches providing a temperature indicator, but does not teach providing it on a handle. Indeed, Conforti does not disclose any additional features to his device except attachment members.

The Office Action argues that placing a temperature indicator anywhere is a matter of design choice, however in the Applicant's invention temperature sensors are placed in specific locations in order to achieve more accurate readings and not for merely aesthetic purposes. Conforti provides no teaching whatsoever regarding the placement of temperature sensors on a window shade in order to make sure that they are thermally insulated. One of ordinary skill in

the art would not find it obvious to take the teaching of Conforti and use it to place a temperature sensor upon the pull down tab of Darby. First, the handle used by Darby does not appear to be capable of having a temperature sensor placed upon it. Secondly, at best, one would take the teaching of Conforti and use it to place a temperature indicator on the shade part of Darby, as taught by Conforti, and not to place it upon a handle. However placing a temperature sensor on the shade part of Darby would not meet the limitations of claims 4, 16, and 31, nor necessarily provide proper thermal insulation. Therefore, even if the teachings of Darby and Conforti were combined one would not arrive at the Applicant's invention.

The Applicant respectfully submits that claims 4, 16, and 31 are additionally allowable for the reasons set forth above and requests notice to that effect.

Claims 5, 17, and 32 are also allowable because neither Conforti nor Darby teaches having a temperature sensor recessed within a handle. Darby teaches having a handle for use with a shade, however the handle disclosed in Darby is in the shape of a pull-tab for the window shade and not the more sizable shape of the handle structure used by the Applicant. The handle in Darby is not amenable to having a temperature sensor placed upon it let alone recessed within the handle. Conforti teaches providing a temperature indicator, but does not teach providing it on a handle. Furthermore, Conforti does not teach recessing a temperature indicator at all.

The Office Action argues that placing a temperature indicator anywhere is a matter of design choice, however in the Applicant's invention temperature sensors are placed in specific locations in order to achieve more accurate readings and not for merely aesthetic purposes. Claims 5, 17, and 32 also require that the temperature sensor be recessed. Recessing the temperature sensor is not merely a matter of placement but also requires additional modification to the structure of the window shade. One of ordinary skill in the art would not find it obvious to take the teaching of Conforti and use it to then alter the structure of the handle in Darby in order to form a recess and then place a temperature sensor within that recess. First, the handle used by Darby does not appear to be capable of having a temperature sensor placed upon it let alone capable of having a recess formed within it. Secondly, at best, one would take the teaching of Conforti and use it to place a temperature indicator on the shade part of Darby, as taught by Conforti, and not to modify Darby in order to form a recess and then place the sensor within the

recess. Therefore, even if the teachings of Darby and Conforti were combined one would not arrive at the Applicant's invention.

The Applicant respectfully submits that claims 5, 17, and 32 are additionally allowable for the reasons set forth above and requests notice to that effect.

#### 4. Conclusion

The Applicant has made an earnest effort to place this application in condition for allowance. If the Examiner feels that a telephone interview would expedite prosecution of this patent application, he is respectfully invited to telephone the undersigned at 215-599-0600.

Respectfully submitted,

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